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In re Patent No. 5,788,178
Issue Date: August 4, 1998
Application No. 08/888,425
Filed: July 7, 1997
Attorney Docket No. RBAR0001-100

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DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.378(b), filed July 8, 2005, to accept the unavoidably delayed payment of a maintenance fee for the above-identified patent.

The petition is DISMISSED.

Procedural History:

- The above-identified patent issued on August 4, 1998.
- The first maintenance fee could have been timely paid during the period from August 4, 2001 through February 4, 2002, or with a late payment surcharge during the period from February 5, 2002 through August 4, 2002.

- No maintenance fee was received, and as such, the patent expired on August 5, 2002.
- The 2 year time period for filing a petition under 37 C.F.R. § 1.378(c) expired on August 5, 2004.

Evidence Presented on Petition:

A review of the petition reveal the following events giving arise to petitioner's assertion of unavoidable delay. Shortly after issuance of the instant patent, patentee Mr. Rolin F. Barrett, Jr., through his law firm the Mills Law Firm, sent a letter with a copy of the patent to Dr. Ronald M. Barrett at Auburn University, to put him on notice of the patent. Almost three years later, during the period for payment of the first maintenance fee in the above patent, the Mills Law Firm sent a reminder letter. However, because the last correspondence address used in the patent was the letter to Dr. Ronald M. Barrett, the reminder letter was mistakenly sent to that address. The reminder letter should have been sent to the patentee, Mr. Rolin F. Barrett. A second reminder was also sent to Dr. Ronald M. Barrett, and finally, the expiration letter. At no point did Dr. Ronald M. Barrett let the Mills Law Firm know that the reminder letters and expiration letter were sent to him erroneously. It was not until patentee engaged another law firm to file a reissue application that the expiration of the instant patent was eventually discovered.

Relevant Statutes, Rules and Regulations:

35 U.S.C. § 41(c) (1) states that:

The Director may accept the payment of any maintenance fee required by subsection (b) of this section which is made within twenty-four months after the six-month grace period if the delay is shown to the satisfaction of the Director to have been unintentional, or at any time after the six-month grace period if the delay is shown to the satisfaction of the Director to have been unavoidable. The Director may require the payment of a surcharge as a condition of accepting payment of any maintenance fee after the six-month grace period. If the Director accepts payment of a maintenance fee after the six-month grace period, the patent shall be considered as not having expired at the end of the grace period.

37 C.F.R. § 1.378(b) provides that:

Any petition to accept an unavoidably delayed payment of a maintenance fee must include:

- (1) The required maintenance fee set forth in §1.20(e) through (g);
- (2) The surcharge set forth in §1.20(i) (1); and
- (3) A showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was

notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

Opinion:

§ 1.378(b)(3) is at issue in this case. Acceptance of a late maintenance fee under the unavoidable delay standard is considered under the same standard for reviving an abandoned application under 35 U.S.C. § 133. This is a very stringent standard. Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present. In re Mattullath, 38 App. D.C. 497, 514-15 (1912) (quoting Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 667-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913).

In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

Moreover, delay resulting from the lack of knowledge or improper application of the patent statutes, rules of practice or the Manual of Patent Examining Procedure, however, does not constitute "unavoidable" delay. See id.; Vincent v. Mossinghoff, 230 USPQ 621, 624 (D.D.C. 1985); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (1891).

While the delay in payment of the maintenance fee may have been unintentional, petitioner has failed to provide an adequate showing that the delay was unavoidable. Rather, the delay is one that could have been avoided with the reasonable exercise of due care. Petitioner is bound by any errors or negligence that may have been committed by his voluntarily chosen counsel. See Link v. Wabash, 370 U.S. 626, 633-34 (1962).

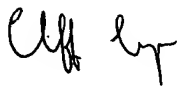
Moreover, patentee argues that had the reminder letters from the Mills Law Firm reached him, he obviously would have paid the maintenance fee, as witnessed by the most spent in prosecuting the reissue application. However, patentee's argument is unpersuasive. The standard is not whether petitioner intended to pay the maintenance fee, but rather, whether the delay in paying the maintenance fee was unavoidable. The "unavoidable" delay standard required a showing of the steps taken to ensure the timely payment of the maintenance fee. The fact that petitioner filed a reissue application, while potentially probative of whether a delay was unintentional, is simply not probative of whether the delay was unavoidable. See In re Patent No. 4,409,763, at 1800.

Conclusion:

Any request for reconsideration of this decision must be filed within **TWO MONTHS** of the mailing date of this decision. Any such petition for reconsideration must be accompanied by the \$130 petition fee set forth in §1.17(h). After decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Commissioner. Accordingly, on request for reconsideration, it is extremely important that petitioner supply any and all relevant information and documentation in order to meet his burden of showing unavoidable delay. This includes statements by all persons with direct knowledge of the cause of the delay, setting forth the facts as they know them.

As petitioner has not presented a grantable petition, the maintenance fee and the surcharge have not been charged. The \$130 submitted with the petition has been refunded to Deposit Account No. 50-1275.

Telephone inquiries concerning this communication should be directed to the undersigned at (571)272-3207.



Cliff Congo
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